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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,533	08/30/2001	Kennith Smith	ALL.P.US0001	9420

7590

09/24/2002

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EXAMINER

MELWANI, DINESH

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 09/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/943,533

Applicant(s)

SMITH, KENNITH

Examiner

Dinesh N Melwani

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11, drawn to a retainer, classified in class 24, subclass 570.
 - II. Claims 12-20, drawn to a wrap comprising an elastomeric band and a retainer, classified in class 24, subclass 16 PB.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions 1 and 2 are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require the mouth portion of the notion to have an axial dimension less than an adjacent band receiving portion of said notch. The subcombination has separate utility such as facilitating the twisting and subsequent tying of a metallic wire.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and the search required for Group 1 is not required for Group 1, restriction for examination purposes as indicated is proper.

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5. During a telephone conversation with Phillip Kenner on 9/11/02 a provisional election was made with traverse to prosecute the invention of a wrap comprising an elastomeric band and a retainer, claims 12-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 15 recites the limitation "said first and second notches" in line 1. There is insufficient antecedent basis for this limitation in the claim. The examiner suggests having claim 15 depend from claim 14.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 12-13 and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Campbell *et al.* (U.S. Patent No. 4,991,265). Campbell discloses a cord tie device as claimed,

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wherein said device comprises an elastomeric band (22), a retainer (26) having a body defining a 'T-shaped' notch for receiving widthwise a portion of said elastomeric band, a band receiving portion of said notch, first (A) and second (B) tabs extending axially over said band receiving portion of said notch and defining a mouth portion (near 36') of said notch, wherein said mouth portion has a width less than the width of said elastomeric band, See Figures 2-6 and column 4, lines 3-18.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-15 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell *et al.* (U.S. Patent No. 4,991,265). Campbell discloses a wrap substantially as claimed, wherein said wrap includes a retainer having a band receiving notch, however Campbell does not include a second notch located substantially diametrically opposed said first notch. The applicant is reminded that duplicating the components of a prior art device is a design consideration within the skill of the art. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Campbell with a second notch, wherein said second notch is formed by tabs similar but opposed to tabs (A, B), such that both sides of said wrap is of a differing color and said wrap may be used to communicate information depending on which side is facing outwards. In regards to claim 18, the applicant is reminded that functional "whereby"

statement does not define any structure and accordingly can not serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Skakoon (U.S. Patent No. 5,232,193), Sayegh (U.S. Patent No. 6,226,839), Studdiford *et al.* (U.S. Patent No. 6,195,846), Norwood (U.S. Patent No. 5,996,204), Cooper (U.S. Patent No. 5,852,851), Bruhm (U.S. Patent No. 5,325,568), Mickel *et al.* (U.S. Patent No. 5,524,327), Lindgren (U.S. Patent No. 5,531,418), DeShon (U.S. Patent No. 5,987,707), Wilk *et al.* (U.S. Patent No. 5,123,913), and Joseph *et al.* (U.S. Patent No. 5,195,218) substantially disclose the invention as claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dinesh N Melwani whose telephone number is 703-305-4546. The examiner can normally be reached on M-F, 8:30-6 except every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-4115.

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DNM

September 12, 2002


ROBERT J. SANDY
PRIMARY EXAMINER